

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Filing Date: June 19, 2000

REMARKS

Applicants would like to thank the Examiner for the thorough examination of the present application. Applicants would also like to thank the Examiner for the courtesies extended during the telephone interview on November 1, 2005.

As helpfully suggested by the Examiner, the independent claims have been amended to more clearly define including an "attachment" with the invention disclosure. The Examiner also indicated during the interview that the amended claims would probably be entered and considered in this Amendment After Final since no new issues are being raised by this amendment. The claim amendments and arguments supporting patentability of the claims are presented in detail below.

I. The Claims Are Patentable

The Examiner rejected independent Claims 1, 12, 22, 31, 42, 52 and 61 over the Hager et al. patent in view of the Kuzma patent.

The present invention, as recited in amended independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises accessing an invention disclosure template form over the intranet, and creating an invention disclosure using the invention disclosure template form. The invention disclosure is created by an inventor and includes information about an invention.

The method further comprises selecting an option in the invention disclosure template form to include an attachment with the invention disclosure. A file is attached to the invention disclosure without the use of a hyperlink.

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Filing Date: **June 19, 2000**

The file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure. The invention disclosure is submitted along with the attached file over the intranet to at least one evaluator via e-mail with a hyperlink to the invention disclosure. Evaluation comments on the invention disclosure and the attached file are transmitted by the at least one evaluator via e-mail.

Independent Claim 1 has been amended to highlight that the invention disclosure is created using a template form accessed over the intranet, with the invention disclosure being created by an inventor and including information about an invention. Independent Claim 1 has also been amended to highlight that the inventor has an option in the invention disclosure template form to include an attachment with the invention disclosure. The file is attached to the invention disclosure without the use of a hyperlink. The file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure.

Support in the specification may be found on page 19, lines 30-31 in which the inventor creates an invention disclosure using a template form. The inventor also has the option of adding attachments to the invention disclosure, as supported by the specification on page 13, lines 26-27, page 15, lines 5-8 and lines 30-32, which provides "a separate attachment can remain fixed to the invention disclosure if additional information is necessary." Attachments include word documents and power point presentations, for example. In addition, FIGS. 16-20 illustrate the steps in the invention

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

disclosure template form for adding an attachment to the invention disclosure. In particular, FIG. 20 illustrates that the contents of the file is uploaded - instead of using a hyperlink.

The present invention advantageously allows separately created files to be attached to the invention disclosure. As what typically happens with inventors, an inventor creates a file on their invention prior to creating and submitting an invention disclosure. The invention disclosure template form includes a provision to include these files as attachments. Without this provision, the additional information in the files would have to be retyped, or as a minimum, cut and pasted into the invention disclosure - both of which are labor intensive and time consuming.

Referring now to the Hager et al. patent, an automation of procedures in a local area network (LAN) environment is disclosed. The procedures are automated in a data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose 1) an attachment for the invention disclosure that is created separate from the invention disclosure and is then attached thereto, and 2) submitting the invention disclosure to at least one evaluator with a hyperlink to the invention disclosure.

The Examiner takes Official Notice that it is well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document. The Examiner thus takes the position that it would have been obvious to combine the teaching of Hager et al. with the idea of sending a hyperlink instead of an entire document.

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

In addition, the Examiner cited the Kuzma patent as disclosing an attachment being included with a document, with the attachment having been created separately from the document. The Examiner thus takes the position that it would have been obvious to combine the teachings of Hager et al. with the teachings of Kuzma regarding creating an attachment separately from a document.

As the Examiner is aware, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim features.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Applicants have done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference. Both the suggestion to make the claimed combination and the reasonable expectation of success must be founded in the prior art and not in Applicants' disclosure.

At the time of the invention, Hager et al. discloses in a local area network (LAN) environment automated procedures in a data processing system with regard to the invention

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

disclosures stored therein. Referring initially to FIG. 2, a high level flow chart illustrating the creation of an invention disclosure document is provided. Reference is directed to column 4, lines 44-53 of Hager et al., which provides:

"As is illustrated, the process begins at block **48** and thereafter passes to block **50** which depicts the creation of an invention disclosure document. In the preferred embodiment, the user is prompted for personal information about each inventor, critical dates information about statutory bar dates, and information about the problem solved and the solution. Next, block **52** gives the user the opportunity to revise the invention disclosure document, if such revision is necessary." (Emphasis added).

As highlighted above, in the preferred embodiment of Hager et al., the user is prompted for information about the problem solved and the solution. This means that the information to be evaluated as part of the invention disclosure must be typed in by the user. If the amount of information to be entered is rather large, then this becomes a labor intensive and time consuming task for the inventor. If the inventor becomes impatient and fails to provide a sufficient amount of information about his invention, then one or more of the evaluators may not properly understand or appreciate the invention - thus resulting in an unfavorable evaluation.

Applicants would also like to point out to the Examiner that an object of the Hager et al. patent is to

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

automatically generate reports and to initiate additional procedures with regards to the invention disclosure document within a data processing system. In other words, Hager et al. provides sufficient detail on soliciting an evaluation vote from users automatically determined in response to identification of a functional area associated with the invention disclosure, as illustrated in FIGS. 3-7. However, Hager et al. simply fails to provide any options to the inventor with respect to entering information "about the problem solved and the solution."

In sharp contrast, the present invention provides options to the inventor when creating an invention disclosure. In particular, the present invention allows a file describing the invention to be attached to the invention disclosure without the use of a hyperlink. The file is created separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure. By attaching the file without the use of a hyperlink, the additional information about the invention remains "fixed" to the invention disclosure (page 15, line 6 in the Applicant's specification). As a result of the inventor being able to easily add information about the invention to the invention disclosure, the evaluators are more likely to provide an accurate evaluation of the invention.

Referring now to the Kuzma patent, e-mail attachments are transmitted from a sender of a network to a recipient of the network. The attachments are stored in a storage device visible to the network and relatively local to the sender. Each attachment has a unique network address associated therewith. The sender requests an e-mail option

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

from the recipient, which provides a configurable e-mail page to the sender in response to the request. An attachment reference comprising the network address of the attachment is supplied to the configurable e-mail page. Reference is directed to column 4, line 65 to column 5, line 6 of Kuzma, which provides:

"Referring now to FIG. 4, there is illustrated an e-mail message format **400** in accordance with a preferred embodiment of the present invention. In the e-mail message format **400** of the present invention, when a user such as **PC 210** of FIG. 2 wishes to send an attachment with an e-mail message to a user such as **PC 212**, the e-mail message **401** is transmitted along with a relatively small attachment reference **402**, instead of actually transmitting the entire attachment file along with e-mail message **401** ..." (Emphasis added.)

As correctly noted by the Examiner, the attachment as disclosed in Kuzma is created separate from the document (i.e., an e-mail), and the attachment is included with the document. The Examiner has taken the position that it would have been obvious to combine the teachings of Hager et al. with the teachings of Kuzma regarding creating an attachment separately from a document.

The Applicants respectfully submit that even if the references were combined as suggested by the Examiner, the claimed invention is still not produced. Kuzma discloses the use of an attachment reference being supplied with the document instead of supplying the contents of the attachment. The attachment reference is essentially a hyperlink to the

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**
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attachment.

In sharp contrast, the present invention has been amended to recite that the file is attached to the invention disclosure without the use of a hyperlink. When a file in the present invention is attached to the invention disclosure, it is "fixed" thereto, i.e., the contents of the file are sent along with the invention disclosure itself. Consequently, since Kuzma discloses that a hyperlink is used to attach a file to an e-mail, there is simply no motivation to selectively combine the references as suggested by the Examiner.

It thus appears that the Examiner is using impermissible hindsight reconstruction to modify the Hager et al. patent in view of the Kuzma patent in an attempt to produce the claimed invention. The prior art references, individually or in combination, do not teach or suggest 1) selecting an option in an invention disclosure template form to include an attachment with the invention disclosure, and 2) attaching a file to the invention disclosure without the use of a hyperlink, wherein the file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure.

Accordingly, it is submitted that amended independent Claim 1 is patentable over Hager et al. in view of Kuzma. Amended independent Claims 12, 22, 31, 42, 52 and 61 are similar to amended independent Claim 1. Therefore, it is submitted that these claims are also patentable over Hager et al. in view of Kuzma. In view of the patentability of the amended independent Claims 1, 12, 22, 31, 42, 52 and 61, it is

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Filing Date: **June 19, 2000**

submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Filing Date: **June 19, 2000**

CONCLUSION

In view of the amendments to the claims and the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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